

### **REMARKS**

In response to the Office Action mailed January 24, 2005, Applicant submits the foregoing amendments and the following comments. Applicant has amended claims 1 and 9, and has added new claims 19-37. Claims 3 and 13-14 are canceled. No new matter has been added. Applicant respectfully requests reconsideration of the above-captioned application in view of the foregoing amendments and the following remarks.

In the Office Action mailed January 24, 2005, the examiner rejected claims 1-4, 7-12, and 15-18 under 35 U.S.C. §102(e) as being anticipated by USPN 6,293,951 (Alferness et al.)

#### **Allowable Subject Matter**

The examiner indicated that claims 5, 6, 13, and 14 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 9 (indicated as allowable) was amended to incorporate claim 14 and, therefore, is in condition for allowance. Claims 10-12 and 15-18 depend from claim 9 are allowable on their own merit and also based on their dependency on claim 9.

Claims 5, 6, and 13 (all indicated as allowable) have been rewritten in independent form as claims 19, 24, and 29, respectively. Thus, claims 19, 24, and 29 are in condition for allowance. Claims 20-23 depend from claim 19 and are allowable on their own merit and based on their dependency on claim 19. Claims 25-28 depend from claim 24 and are allowable on their own merit and based on their dependency on claim

24. Claims 30-37 depend from claim 29 and are allowable on their own merit and based on their dependency on claim 29.

Applicant provides the following chart to assist the examiner in sorting through the claims that have been amended or added to incorporate allowable subject matter.

Claim #	Status	Subject Matter Incorporated
9 - Independent	Amended	Claims 9 and 14
10		Claim 10
11		Claim 11
12		Claim 12
13	Cancelled	
14	Cancelled	
15		Claim 15
16		Claim 16
17		Claim 17
18		Claim 18
19 - Independent	New	Claims 1 and 5
20	New	Claim 2
21	New	Claim 4
22	New	Claim 7
23	New	Claim 8
24 - Independent	New	Claims 1 and 6
25	New	Claim 2
26	New	Claim 4
27	New	Claim 7
28	New	Claim 8
29 - Independent	New	Claims 9 and 13
30	New	Claim 10
31	New	Claim 11
32	New	Claim 12
33	New	Claim 14
34	New	Claim 15
35	New	Claim 16
36	New	Claim 17
37	New	Claim 18

### Rejection Under 35 U.S.C. §102

The examiner rejected claims 1-4, 7-12, and 15-18 under 35 U.S.C. § 102(e) as being allegedly anticipated by USPN 6,293,951 (Alferness et al.), which describes a lung reduction device, system, and method. However, Applicant respectfully submits that claims 1-4, 7-12, and 15-18 recite subject matter that is neither taught nor suggested by Alferness.

### Claim 1 and Dependent Claims

Claim 1, as amended, recites:

A method of restricting fluid flow through a bronchial passageway in a patient's lung comprising:

providing a flow control element comprising a plurality of leaflets movable from a closed position to an open position, the leaflets each having a distal surface, a proximal surface opposite the distal surface, and an engagement surface, the distal surfaces of the leaflets engaging each other in the closed position;

positioning the flow control element through the patient's trachea into the bronchial passageway; and

anchoring the flow control element within the bronchial passageway;

wherein the proximal surfaces of the leaflets are engaged by fluid when the patient inhales to urge the distal surfaces into engagement with each other to maintain the leaflets in the closed position.

Alferness fails to disclose several features recited in claim 1. For example, Alferness fails to disclose providing a flow control element wherein proximal surfaces of leaflets are engaged by fluid when the patient inhales to urge distal surfaces of the leaflets into engagement with each other to maintain the leaflets in the closed position.

Alferness discloses a valve 120 having a pair of flaps with proximal and distal surfaces. (Alferness 7:1-15; Figures 12, 13.) The flaps are formed by a slit 122 in a

base of the valve 120. The flaps do not overlap one another and do not have a length that would permit them to overlap one another. Thus, the distal surfaces of the flaps in the Alferness valve do not and cannot engage each other. Therefore, Alferness does not disclose all of the limitations of claim 1. Claims 2 and 4-8 depend from claim 1 and are allowable based on their own merit and on their dependency on claim 1.

Accordingly, because Alferness fails to disclose all of the limitations of claim 1 and its dependent claims, Applicant respectfully submits that the rejection under 35 U.S.C. § 102(e) should be withdrawn.

#### Claim 9 and Dependent Claims

As discussed above, Applicant amended claim 9 to incorporate claim 14, which the examiner indicated recited allowable subject matter. Claim 9 and its dependent claims are therefore in condition for allowance.

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

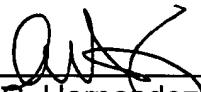
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If the Examiner has any questions regarding the foregoing, he is cordially invited to contact the undersigned so that any such matters may be promptly resolved.

Respectfully submitted,

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